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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,316	02/24/2004	Zachary E. Berndlmaier	BUR920030156US1	2315
29154	7590	02/05/2008		
FREDERICK W. GIBB, III Gibb & Rahman, LLC 2568-A RIVA ROAD SUITE 304 ANNAPOLIS, MD 21401			EXAMINER BRITT, CYNTHIA H	
			ART UNIT 2117	PAPER NUMBER
			MAIL DATE 02/05/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/708,316

Applicant(s)

BERNDLMAIER ET AL.

Examiner

Cynthia Britt

Art Unit

2117

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-10 and 12-28 are pending in the present application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/7/07 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 and 12-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

MPEP § 2106 states:

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

This list of examples is not intended to be exhaustive.

MPEP § 2111.04 states:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure.

As highlighted in the independent claims below, these terms raise a question as to which limitations are further limiting in the claim language. Therefore, these independent claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As such these claims will not be further considered with respect to the prior art.

1. An autonomously self-monitoring and self-correcting integrated circuit device comprising: a self-testing controller **adapted to** periodically and autonomously perform on- chip performance self-testing of said integrated circuit device, **wherein** said performance self-testing comprises autonomous application of functional test sequences to said integrated circuit device until failure; a comparator **adapted to** evaluate whether results from said self-testing are within acceptable limits; and a

processor **adapted to** autonomous adjust parameters of said integrated circuit device until said results from said self-testing are within said acceptable limits.

8. An autonomously self-monitoring and self-correcting integrated circuit device comprising: a self-testing controller **adapted to** periodically perform on-chip performance self- testing of said integrated circuit device throughout the useful life of said integrated circuit device, **wherein** said performance self-testing comprises application of functional test sequences to said integrated circuit device until failure; a comparator **adapted to** evaluate whether results from said self-testing are within acceptable limits; and a processor **adapted to** permanently self-adjust parameters of said integrated circuit device by altering the voltage supplied to portions of said integrated circuit device until said results from said self-testing are within said acceptable limits.

15. A method of continuously and autonomously self- monitoring and self-adjusting the operation of an integrated circuit device, said method comprising: periodically performing, by said integrated circuit device, on-chip performance self-testing of said integrated circuit device, **wherein** said integrated circuit device comprises a product to be tested and **wherein** said performing of said performance self- testing comprises applying functional test sequences to said integrated circuit device until failure; self-evaluating, by said integrated circuit device, whether results from said self- testing are within acceptable limits; and self-adjusting, by said integrated circuit device, parameters of said integrated circuit device until said results from said self-testing are within said acceptable limits.

22. A method of continuously and autonomously self- monitoring and self-adjusting the operation of an integrated circuit device throughout the useful life of said integrated circuit device, said method comprising: periodically performing, by said integrated circuit device, on-chip performance self-testing of said integrated circuit device throughout said useful life of said integrated circuit device, **wherein** said integrated circuit device comprises a product to be tested and **wherein** said performing of said performance self-testing comprises apply functional test sequences to said integrated circuit device until failure; self-evaluating, by said integrated circuit device, whether results from said self-testing are within acceptable limits; and permanently self-adjusting, by said integrated circuit device, parameters of said integrated circuit device by altering the voltage supplied to portions of said integrated circuit device until said results from said self-testing are within said acceptable limits.

As per claims 2-7, 9-10, 12-14, 16-21, and 23-28, these claims are dependent on the independent claims above and therefore inherit the 35 U.S.C. 112, second paragraph issues of the independent claims above.

Claims 2-7, 9-10, 12-14, 16-21, and 23-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above claims seem to violate 37 CFR 1.75 as being a substantial duplicate of the claims they depend on based on the newly added "incorporated by reference"

limitation in each of these claims. As this effectively amounts to an incorporation of itself, See MPEP 608.01(p)(I):

The Director has considerable discretion in determining what may or may not be incorporated by reference in a patent application. *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968).

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form 892 attached.

The examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider each of the cited references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage disclosed by the examiner.

The examiner invites applicant to call and schedule an interview prior to responding to this office action if there are issues in the above rejection which are not

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clear or if applicant believes it would be helpful to discuss the claim language required to overcome the rejections above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Britt whose telephone number is 571-272-3815. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on 571-272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cynthia Britt
Primary Examiner
Art Unit 2117
1-28-08